

REMARKS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Final Official Action provided. Upon entry of the present amendment, the claims 1, 21 and 23 will have been amended and claims 33-35 will have been added. Claims 1-2, 4-5, 21, 23, 27-28 and 30-35 are pending in the present application for consideration by the Examiner. As discussed above, Applicant notes that independent claims 1, 21 and 23 have each been amended to recite a cylindrical holder, and Applicant further notes that new claims 33-35 are each directed to a ring-shaped positioning member configured to coaxially engage the cylindrical holder.

The Examiner has rejected claims 1-2, 21, 23 and 27-28 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,416,837 to NEEFE. Applicant respectfully traverses the Examiner's rejection. As noted in the above Statement of Substance of Interview, Applicant submits that the applied NEEFE reference (as well as the other references of record) fails to teach or disclose at least the claimed cylindrical holder of independent claims 1, 21 and 23. Rather, NEEFE is directed to a spin-cast contact lens manufacturing method which uses no cylindrical holders that surround and hold a base member. It is thus submitted that the present claimed invention is patentably distinct from NEEFE and the other references of record.

P19101.A11

Absent a disclosure in a single reference of each and every element cited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 1, 21 and 23, these claims, and the claims dependent therefrom, are not anticipated thereby.

With respect to rejected dependent claims 2, 4-5, 27-28 and 30-32, since these claims (as well as newly added claims 33-35) are dependent from one of claims 1, 21 or 23, which are allowable for at least the reasons discussed *supra*, these pending dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record.

Further, Applicant respectfully submits that the amendment to claims 1, 21 and 23 does not raise new issues that require the Examiner to conduct an additional search, nor do Applicant's newly-added claims 33-35.

Thus, Applicants respectfully submit that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully request the Examiner to indicate the allowance the present application.

SUMMARY AND CONCLUSION

In view of the foregoing, it is submitted that the present amendment is in proper form and that none of the references either taken together or taken alone in any proper combination thereof, anticipate or render obvious Applicant's invention. In addition, the applied references of record have been discussed and distinguished, while significant features of the present invention have been pointed out. Accordingly, consideration of the present amendment, reconsideration of the outstanding Official Action and allowance of the present application and all of the claims therein are respectfully requested and are now believed to be appropriate.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and with respect to the claimed features argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

P19101.A11

Should the Examiner have any questions or comments regarding the present response, or this application, the Examiner is respectfully requested to contact the undersigned at the below listed telephone number.

Respectfully submitted,
Toru CHIBA

W. H. Bernstein
Reg. No. 44,550

Bruce H. Bernstein
Reg. No. 29,027

August 5, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
(703) 716-1191